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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,286

07/09/2007

Yasumasa Dekishima

P30416

6444

7055 7590 03/23/2010
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EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

NOTIFICATION DATE

DELIVERY MODE

03/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary	Application No. 10/588,286	Applicant(s) DEKISHIMA ET AL.	
	Examiner Paul A. Zucker	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/15/07, 4/23/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III in the reply filed on 5 February 2010 is acknowledged. The traversal is on the ground(s) that the election of species requirement should be withdrawn. The Examiner accedes to Applicants' request in view of the fact that no search burden is incurred in searching the process for the genus of 1-methyl alkylmalonic acids. With respect to the other elements, the requirement is still deemed proper and is therefore made FINAL. Claims 7, 9-11, 14 and 15 are held withdrawn from consideration as being drawn to a non-elected invention.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prout et al (Journal of Organic Chemistry, Two Acids Containing the Active 2-Heptyl Group, 1962, 27, pages 1488-1490) when considered with Francke (US 4, 853, 217 08-1989).

Instantly claimed is a method for producing (R)- or (S)-1-methylalkyl malonic acid represented by formula (1) as set forth in instant claim 8.

Prout teaches (Paragraph bridging pages 1488 and 1489 to page 1489, paragraph bridging columns 1 and 2), a process for the synthesis of optically active 2-

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methyloctanoic acid via reaction of 2-bromohepanol with phosphorous tribromide (PBr_3) to give the corresponding bromide, reaction of the bromide with the sodium salt of dibutylmalonate formed from dibutylmalonic acid and sodium butoxide formed *in situ* by reaction of sodium and butanol. Prout teaches (Page 1489, column 1, 1st 2 full paragraphs) that racemization is problem that is encountered when converting the optically active alcohol to the corresponding bromide. Prout teaches (Page 1489, column 1, last 2 full paragraphs-column 2, middle) the saponification of the ester to the malonic acid which corresponds the instant compound of formula (1) in which $\text{R}^1 = \text{C}_5\text{-alkyl}$, followed by decarboxylation to give 2 -methyloctanoic acid.

The difference between the process taught by Prout and that instantly claimed is that instead of a bromide leaving group in the alkylating agent as employed by Prout, a sulfonyloxy leaving group is instantly employed.

Francke, however teaches (Column 2, lines 34-40) a process for the synthesis of 2-methylheptanoic acid which is essentially similar to that employed by Prout except for the fact that Francke converts the required alcohol to the corresponding sulfonate ester before using it to alkylate sodium malonate.

One of ordinary skill in the art would have been motivated to modify Prout's process by activating the optically active alcohol by conversion to the sulfonate ester, as taught by Franke, in order to avoid racemization of the alcohol as taught by Prout to occur when PBr_3 is employed. Since the carbon-oxygen bond is not broken in the

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formation of the sulfonate ester as it is in the formation of the bromide there would have been a reasonable expectation for success.

Thus the instantly claimed process would have been obvious to one of ordinary skill in the art.

Conclusion

4. Claims 7-11, 14 and 15 are pending. Claim 8 is rejected. Claims 7, 9-11, 14 and 15 are held withdrawn from consideration as being drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/
Primary Examiner, Art Unit 1621